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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,546	02/11/2002	Jenny M. Pelter	884.616US1	5100

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402-0938

EXAMINER

DUNCAN, MARC M

ART UNIT	PAPER NUMBER
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2113

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,546

Applicant(s)

PELNER, JENNY M.

Examiner

Marc M. Duncan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15,17-24 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15,17-24,26-30 and 33 is/are rejected.
- 7) ☒ Claim(s) 31 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

FINAL ACTION

Status of the Claims

Claims 2-8, 17, 26 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

Claims 24-30 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter

Claims 1, 3-15, 17-24 and 26-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff.

Claims 31-32 are objected to.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-8, 17, 26 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of claims 2-8, 17 and 26 depend from a non-existent claim.

Claim 33 recites the limitation "the computer system" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 24-30 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The medium is not computer-readable and the instructions are not executing on a computer or processor. See MPEP 2106.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-15, 17-24 and 26-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff.

Regarding claim 1:

Wolff teaches starting a computer system comprising at least one component in Fig. 2A.

Wolff teaches determining whether the at least one component has previously been successfully tested in Fig. 2B, col. 2 lines 65-67 and col. 3 lines 15-18.

Wolff teaches if not, testing the at least one component in Fig. 2B.

Wolff teaches otherwise, not testing the at least one component, wherein if the at least one component is successfully tested, permanently storing an indication that the at

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least one component has been successfully tested in Fig. 2B, col. 2 lines 65-67, col. 3 lines 15-18 and col. 4 lines 28-34. Wolff teaches storing the successful test indication in a ROM, which the examiner determined represents permanently storing the memory. While the indication may be altered for a short period to perform a field test, the same indication is always stored when the test is successful and is therefore permanent under a reasonable definition of the term as accepted by those of ordinary skill in the art.

Regarding claim 3:

Wolff teaches wherein the indication comprises a predetermined bit pattern in Fig. 2B. A signature is a predetermined bit pattern.

Regarding claim 4:

Wolff teaches wherein determining further comprises checking for the predetermined bit pattern in Fig. 2B.

Regarding claim 5:

Wolff teaches if such predetermined bit pattern is present: booting the computer system in Fig. 2B.

Regarding claim 6:

Wolff teaches if such predetermined bit pattern is present: determining whether a field test is ordered, and if so, testing the at least one component, and otherwise, booting the computer system in Fig. 2B and col. 4 line 63-col. 5 line 6.

Regarding claim 7:

Wolff teaches after testing: determining whether the test was successful; and if so, providing an indication that the at least one component has been tested, and

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otherwise, providing an error indication in col. 4 line 63-col. 5 line 6 and col. 5 lines 63-67. Leaving the test signature in the bootmode signature area comprises an error indication.

Regarding claim 8:

Wolff teaches after storing: restarting the computer system in col. 4 lines 46-49 and col. 5 lines 60-63.

Regarding claim 9:

Wolff teaches if the at least one component is tested: determining whether the test was successful, and if so, storing an indication that the at least one component has been tested, and otherwise, providing an error indication in col. 4 line 63-col. 5 line 6 and col. 5 lines 57-67. Leaving the test signature in the bootmode signature area comprises an error indication.

Regarding claim 10:

Wolff teaches if the at least one component is not tested: booting the computer system in Fig. 2B.

Regarding claim 11:

Wolff teaches wherein booting comprises: initializing the at least one component; and loading a portion of an operating system into memory in Fig. 2B.

Regarding claim 12:

Wolff teaches wherein determining further comprises checking for the presence of a test to test the at least one component in Fig. 2B and col. 4 line 63-col. 5 line 6.

Regarding claim 13:

Wolff teaches if such a test is not present: booting the computer system in Fig. 2B.

Regarding claim 14:

Wolff teaches wherein checking comprises checking for the presence of a predetermined bit pattern in col. 4 line 63-col. 5 line 6.

Regarding claim 15:

Wolff teaches upon receiving a command to start the computing device, determining whether the at least one component has previously been successfully tested in Fig. 2B, col. 2 lines 65-67 and col. 3 lines 15-18.

Wolff teaches if not, testing the at least one component in Fig. 2B.

Wolff teaches otherwise, not testing the at least one component, wherein if the at least one component is successfully tested, permanently storing an indication that the at least one component has been successfully tested in Fig. 2B, col. 2 lines 65-67, col. 3 lines 15-18 and col. 4 lines 28-34. Wolff teaches storing the successful test indication in a ROM, which the examiner determined represents permanently storing the memory. While the indication may be altered for a short period to perform a field test, the same indication is always stored when the test is successful and is therefore permanent under a reasonable definition of the term as accepted by those of ordinary skill in the art.

Regarding claim 17:

Wolff teaches after storing: restarting the computing device in col. 4 lines 46-49 and col. 5 lines 60-63.

Regarding claim 18:

Wolff teaches if the at least one component is tested: determining whether the test was successful, and if so, storing an indication that the at least one component has been tested, and otherwise, providing an error indication in col. 4 line 63-col. 5 line 6 and col. 5 lines 57-67. Leaving the test signature in the bootmode signature area comprises an error indication.

Regarding claim 19:

Wolff teaches if the at least one component is not tested: booting the computing device in Fig. 2B.

Regarding claim 20:

Wolff teaches wherein, in booting, the at least one component is initialized, and a portion of an operating system is loaded into memory in Fig. 2B.

Regarding claim 21:

Wolff teaches wherein, in determining, a check is made for the presence of a test to test the at least one component in Fig. 2B and col. 4 line 63-col. 5 line 6.

Regarding claim 22:

Wolff teaches if such a test is not present, booting the computer system in Fig. 2B.

Regarding claim 23:

Wolff teaches wherein, in checking, a check is made for the presence of a predetermined bit pattern in col. 4 line 63-col. 5 line 6.

Regarding claim 24:

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The claim is rejected as the computer readable medium with computer executable instructions that, when executed, cause the method of claim 1 to be performed.

Regarding claim 26:

The claim is rejected as the computer readable medium with computer executable instructions that, when executed, cause the method of claim 8 to be performed.

Regarding claim 27:

The claim is rejected as the computer readable medium with computer executable instructions that, when executed, cause the method of claim 9 to be performed.

Regarding claim 28:

The claim is rejected as the computer readable medium with computer executable instructions that, when executed, cause the method of claim 10 to be performed.

Regarding claim 29:

The claim is rejected as the computer readable medium with computer executable instructions that, when executed, cause the method of claim 11 to be performed.

Regarding claim 30:

The claim is rejected as the computer readable medium with computer executable instructions that, when executed, cause the method of claim 13 to be performed.

Allowable Subject Matter

Claims 31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc M. Duncan whose telephone number is 571-272-3646. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

md


ROBERT BEAUSOLIEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2103